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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,674	09/28/2005	Paul Butcher	MARKS9.002APC	7391
20995 7590 01/13/2009 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER NEURAUTER, GEORGE C				
ART UNIT 2443		PAPER NUMBER		
NOTIFICATION DATE 01/13/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/534,674

Applicant(s)

BUTCHER, PAUL

Examiner

George C. Neurauter, Jr.

Art Unit

2443

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 11 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 10/23/2008

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-5, 11, and 16 are currently presented and have been examined.

Response to Arguments

Applicant's arguments filed 23 October 2008 have been fully considered but they are not persuasive.

The Applicant argues that Mousseau does not teach or suggest sending a move command from a mobile terminal to a relay server, sending a protocol email containing the move command from the relay server to a user's email address and retrieving at a static terminal the protocol email from an email server. The Examiner respectfully disagrees in view of the broadest reasonable interpretation of the claims and the teachings and suggestions of Mousseau.

The specification disclosed:

"In a preferred embodiment the mobile terminal sends the move command back to the server by means of a "command" or "protocol" mail, that is encoding the command as a very short email." (see page 8, first paragraph)

In view of the specification, a "protocol" or "command" mail or "protocol email" as recited in the claims is simply an email that contains the command.

Mousseau disclosed:

"FIG. 1 shows an E-mail message A being communicated over LAN 14 from computer 26 to the user's desktop system 10 (also shown in FIG. 1 is an external message C, which could be an E-mail message from an Internet user, or could be a command message from the user's mobile device 24). Once the message A (or C)

reaches the primary message store of the host system 10, it can be detected and acted upon by the redirection software 12." (see column 12, lines 20-26)

Therefore, Mousseau expressly discloses that email received by the "static terminal" may be an email which contains the move command. As is known in the art, email is sent and retrieved by mail user agents on computer which utilize respective mail servers on different networks. Since Mousseau expressly discloses that use of a wireless gateway or "relay server" is used in conjunction with the "mobile terminal", any email sent by the mobile terminal is handled by the network of the "mobile terminal". Conversely, the "static terminal" communicates with its email server to send or retrieve email on its network separate from the "mobile terminal".

Mousseau further disclosed:

"In another alternative configuration of the present invention, a redirector program operates at both the host system and at the user's mobile data communication device. In this configuration, the user's mobile device operates similarly to the host system described below, and is configured in a similar fashion to push certain user-selected data items from the mobile device to the user's host system (or some other computer) upon detecting an event trigger at the mobile device. This configuration provides two-way pushing of information from the host to the mobile device and from the mobile device to the host." (column 5, lines 20-30)

"A user of the present invention can configure the redirector program 12 to push certain user-selected data items to the user's mobile data communication device 24 when the redirector 12 detects that a particular user-defined event trigger (or trigger

point) has taken place. User-selected data items preferably include E-mail messages, calendar events, meeting notifications, address entries, journal entries, personal alerts, alarms, warnings, stock quotes, news bulletins, etc., but could, alternatively, include any other type of message that is transmitted to the host system 10, or that the host system 10 acquires through the use of intelligent agents, such as data that is received after the host system 10 initiates a search of a database or a website or a bulletin board. In some instances, only a portion of the data item is transmitted to the mobile device 24 in order to minimize the amount of data transmitted via the wireless network 22. In these instances, the mobile device 24 can optionally send a command message to the host system to receive more or all of the data item if the user desires to receive it.

The user-defined event triggers that can be detected by the redirector program 12 preferably include external events, internal events and networked events. External events preferably include: (1) receiving a command message (such as message C) from the user's mobile data communication device to begin redirection, or to execute some other command at the host, such as a command to enable the preferred list mode, or to add or subtract a particular sender from the preferred list; (2) receiving a similar message from some external computer; and (3) sensing that the user is no longer in the vicinity of the host system; although, alternatively, an external event can be any other detectable occurrence that is external to the host system. Internal events could be a calendar alarm, screen saver activation, keyboard timeout, programmable timer, or any other user-defined event that is internal to the host system. Networked events are user-defined messages that are transmitted to the host system from another

computer coupled to the host system via a network to initiate redirection. These are just some of the events that could be used with the present invention to initiate replication of the user-selected data items from the host system 10 to the mobile device 24.

FIG. 1 shows an E-mail message A being communicated over LAN 14 from computer 26 to the user's desktop system 10 (also shown in FIG. 1 is an external message C, which could be an E-mail message from an Internet user, or could be a command message from the user's mobile device 24). Once the message A (or C) reaches the primary message store of the host system 10, it can be detected and acted upon by the redirection software 12. The redirection software 12 can use many methods of detecting new messages. The preferred method of detecting new messages is using Microsoft's RTM. Messaging API (MAPI), in which programs, such as the redirector program 12, register for notifications or 'advise syncs' when changes to a mailbox take place. Other methods of detecting new messages could also be used with the present invention." (see column 10, line 46-column 11, line 34)

As shown in Mousseau, software known as a "redirector" operates to generate and detect the move commands. In view of the teachings of Mousseau, Mousseau at least reasonably suggests that the "mobile terminal" sends, through use of its redirector software, a "protocol email" containing the move command to its respective "relay server" which handles email received from the mobile terminal, the relay server then sends the "protocol email" along to the mail server of the "static terminal" through the use of the user's email address of the static terminal, and that the "static terminal"

detects the "protocol email" through the use of the redirector software and retrieves the "protocol email" from its mail server.

Therefore, the Examiner submits that Mousseau does at least reasonably suggest, if not teach, the amended claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 11, and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,779,019 B1 to Mousseau et al.

Regarding claim 1, Mousseau disclosed a method of managing emails in a mobile e-mail system, the mobile email system comprising a mobile terminal ("mobile data communication device") having a local storage structure, and an email server coupled to a static terminal ("host system" or "user's desktop PC") and to a relay server ("wireless gateway"), said mobile terminal being provided with data communication facilities coupling it to said relay server, said static terminal having a folder-based data storage structure for storing emails received by a user of said static terminal (see at least column 3, lines 25-51 and column 18, lines 28-51), said static terminal also being configured to provide said received email to said email terminal via said email server

and said relay server (see at least column 3, lines 1-25), said mobile terminal locally duplicating at least a portion of said static terminal folder-based data storage structure, whereby said user is able to manage emails sent to a single address using said static and said mobile terminal (see at least column 3, lines 1-17 and column 18, lines 28-51), the method comprising:

inputting, at said mobile terminal, a command from said user to move an email from a first folder of said local storage structure to a second folder of said local storage structure; deleting said email from said local storage structure of said mobile terminal responsive to said user move command; sending said move command from said mobile terminal to said relay server; sending a protocol email containing said move command from said relay server to said user's single address; and retrieving, at said static terminal, said protocol email from said email server. (see at least column 5, lines 20-30, column 6, line 63-column 7, line 14, column 10, line 46-column 11, line 34, column 18, lines 28-51 and especially column 22, lines 57-column 23, line 23)

Claims 11 and 16 are also rejected since these claims recite substantially the same limitations as recited in claim 1. "Documents" are interpreted to be a broader term for "emails", therefore, the teachings of Mousseau also encompass "documents".

Regarding claim 2, Mousseau disclosed the method as claimed in claim 1 wherein said first folder comprises an incoming mail-box of said mobile terminal. (see at least column 19, lines 27-44, specifically a folder type "inbox") (see also column 18, lines 28-51)

Regarding claim 3, Mousseau disclosed the method as claimed in claim 1 wherein said second folder of said storage structure local to said mobile terminal has associated property data for specifying said second folder as a folder in which emails are not to be stored locally in said mobile terminal, and wherein said deleting is conditional upon said property data. (see at least column 6, line 63-column 7, line 14, column 18, lines 28-51 and especially column 22, lines 57-column 23, line 23)

Regarding claim 4, Mousseau disclosed the method as claimed in claim 1 wherein said sending of said move command comprises encoding said move command as a command email ("command message") and sending said command email. (see at least column 11, lines 20-34)

Regarding claim 5, Mousseau disclosed the method as claimed in claim 1 wherein said mobile terminal is in intermittent contact with said email server, said method further comprising connecting said mobile terminal to said server via an internet connection. (see at least column 10, lines 20-45)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571)272-3918. The examiner can normally be reached on the hours between 8:30am-5:00pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger, can be reached on 571-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George C. Neurauter, Jr./
Primary Examiner, Art Unit 2443